

**REMARKS**

Claims 1-13, 15-21 and 23-25 are all the claims pending in this application. Reconsideration of the subject application and allowance of the claims are respectfully requested for reasons that follow.

**Rejections Under 35 U.S.C. § 102(e)**

Claims 1-3, 7-12 and 16-18 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Adams et al. (U.S. Publication No. 2003/0083943) ("Adams").

Applicant responded to the section 102(e) rejection over Adams by submitting a declaration under 37 C.F.R. § 1.131 in an effort to "swear behind" the Adams reference. In particular, Applicant's Rule 131 declaration establishes a date of conception prior to the Adams reference and diligence from just prior to the date of the Adams reference (January 21, 2000) to the date of Applicant's constructive reduction to practice on March 8, 2000. The Office Action takes the position that Applicant's Rule 131 declaration establishes conception of the subject invention prior to January 21, 2000. However, the Office Action also determined that the averments establishing diligence in the Rule 131 declaration were "without any supporting evidence." See Office Action, Page 2. Applicant respectfully submits that the Office Action's contention regarding diligence is legally and factually incorrect and should be withdrawn.

Contrary to the position taken in the Office Action, the averments regarding diligence in Applicant's Rule 131 declaration *is* evidence of diligence for purposes of 37 C.F.R. § 1.131, and do not require supporting evidence. Ex parte Hook, 102 U.S.P.Q. 130 (Bd. App. 1953); Manual of Patent Examining Procedure, § 715.07. "We are unable to sustain the examiner's holding that the averments made by an affiant in a

Rule 131 affidavit must be corroborated. Such a requirement is unauthorized as Rule 131 does not provide in terms for corroborative affidavits. . . . An applicant has the right to stand upon his own affidavit if he so elects." Ex parte Hook, 102 U.S.P.Q at 131. "Averments made in a 37 C.F.R. 1.131 affidavit or declaration do not require corroboration; an applicant may stand on his or her own affidavit or declaration if he or she so elects." Manual of Patent Examining Procedure, § 715.07. Accordingly, the Office Action's contention that Applicant has not demonstrated due diligence based on a lack of supporting evidence is without merit and should be withdrawn.

Moreover, the averments in Applicant's Rule 131 declaration clearly establish due diligence. In particular, Applicant's Rule 131 declaration states facts establishing diligence during the period prior to January 21, 2000 and until the patent application was filed with the Patent Office on March 8, 2000. For example, the Applicant's Rule 131 declarant states that Mr. Rothkopf "carefully reviewed and provided comments on the draft application to Rick Fernandez. I addition, I received, reviewed and signed the Inventor's Oath and Declaration and Assignment . . ." Rothkopf Declaration, ¶ 8. In addition to the facts recited in Applicant's declaration, the record shows that Mr. Rothkopf reviewed and signed the declaration and power of attorney declaration on February 25, 2000 as well as the assignment on February 25, 2000. Courts have routinely found activity associated with preparing and filing a patent application to be evidence of diligence. Justus v. Appenzeller, 177 U.S.P.Q. 332, 341 (USPTO 1971) (finding "activities directed towards the preparation and filing of the Justus application . . . [to] clearly constitute sufficient reasonable diligence" during the relevant one month period); Connin v. Andrews, 1984 Pat. App. LEXIS 18, \*26-29 (1984) (finding

reasonable diligence during relevant one month period based on the activities of patent attorney and patent draftsman).

Accordingly, Applicant respectfully submits that the evidence of record demonstrates that the Applicant was reasonably diligent during the relevant time period. Applicant therefore respectfully requests withdrawal of the rejection of claims 1-3, 7-12 and 16-18 under 35 U.S.C. § 102(e) based upon the Adams reference.

**Rejections Under 35 U.S.C. § 103**

Claims 4-6, 13, 15, 19, 20, 23 and 24 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Adams in view of Steinman et al. (U.S. Publication No. 2003/0105663) ("Steinman"). For reasons set forth above, the Adams reference is not available as prior art against the subject application. Accordingly, the rejections under 35 U.S.C. § 103(a) based on Adams in combination with Steinman are improper and should be withdrawn.

**Conclusion**

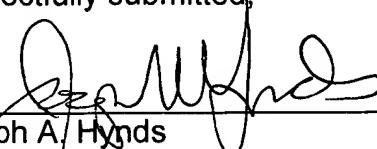
In view of the foregoing remarks, Applicant respectfully submits that each of the presently pending claims in this application is in condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of claims and to pass this application to issue. If it is determined that a further telephone conference with the undersigned would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

A Petition for a three-month extension of time and the corresponding fee are filed concurrently herewith.

The Commissioner is hereby authorized to charge any fees and to credit any overpayments that may be required by this paper under 37 C.F.R. §§ 1.16 and 1.17 to Deposit Account No. 02-2135.

Respectfully submitted,

By

  
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